

U.S. Patent Appln. No. 10/038,719
Response Dated Jan. 4, 2006
Reply to Advisory Action of Dec. 20, 2005
Docket No. BOC9-2000-0061 (196)

REMARKS/ARGUMENTS

These remarks are submitted in response to the Advisory Action dated December 20, 2005 (hereinafter Advisory Action). As this response is timely filed before the expiration of the 3-month shortened statutory period, no fee is believed due.

Claims 1, 5-6, 8-10, 12, 14, 17-20, 24, 25, 27-29, 31, 33 and 36-37 were rejected in the Final Office Action dated October 4, 2005 (hereinafter Office Action) under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application No. 2002/002313 to Wu, *et al.* (Wu). Claims 3-4, 13, 15, 22, 23, 32, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu in view of U.S. Patent Number 6,697,474 to Hanson, *et al.* (Hanson).

In Applicants' previous response to the Office Action, Applicants amended independent Claims 1, 9, 18, 20, and 28. Applicants respectfully reiterate that Wu fails to expressly or inherently teach every aspect of independent Claims 1, 9, 18, 20, and 28, as amended.

Wu is directed to the transfer of electronic data between a sender and a recipient. Electronic data transfer in Wu includes enabling instant messaging communications between the sender and at least one recipient. (See, e.g., paragraphs 0005 and 0014; see also Abstract.)

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Applicants respectfully maintain that the portions of Wu (paragraphs 0069-0075) cited in the Advisory Action can not be read in isolation. The cited portions pertain to Wu's procedure for transferring "audio data" between a sender and recipient using a host, and must be read in the context of the other portions pertaining to this particular procedure of Wu. (See paragraphs 0059-0075.)

Wu explicitly describes the procedure as being carried out with both the sender and the recipient devices each having an API for establishing an open connection with the host. (See paragraphs 0062.) Specifically, the sender and recipient establish a connection by each connecting to the host. It is a "buddy list" residing on the host that "facilitates" communication between the sender and recipient. (See paragraphs 0064 and 0066.)

Wu does rely on instant messaging, but the instant message from a sender initially goes to the host. (Paragraph 0067.) The host in Wu "verifies" the instant message and determines the recipients "capabilities." (Paragraph 0068.) To be "talk enabled" – that is to communicate by the transfer of audio data – each of the sender and recipient must have appropriate software as well as audio equipment. (Paragraph 0068.) After receiving an instant message from a sender and determining the recipient's capability, an instant message is sent, according to Wu, to the recipient. (Paragraphs 0069-0071.)

Once the instant message has passed from the sender through the host to the recipient, a "talk session" can be initiated when both the sender and recipient in Wu are

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talk enabled. The talk session is initiated by the sender's sending a "talk request" to the host, which authenticates the request. (Paragraphs 0072.) The host after verifying the talk request sends the request to the recipient. (Paragraphs 0073.) The recipient then has the option of accepting the request or not. (Paragraph 0074.)

When viewed in its entire context, Wu's procedure for facilitating a talk session exhibits a number of significant differences from Applicants' invention. For example, Wu does not expressly or inherently teach inserting in an instant message a voice conference identifier comprising a voice conference call list identifying conference call nodes, as recited in each of amended independent Claims 1, 9, 18, 20, and 28. Wu makes no mention of a voice conference call list identifying conference call nodes. More fundamentally, Wu does not expressly or inherently teach embedding such a list in an instant message.

Wu discloses a buddy list, but Wu's buddy list is a list of system "subscribers," not potential conference call nodes. Moreover, Wu's buddy list resides on a host accessed by a sender of an instant message. Wu's buddy list is not embedded in an instant message as recited in each of the amended independent claims.

Wu further fails to teach, expressly or inherently, embedding computer program code in an instant message. Wu describes only information that can be included in an instant message: message type, screen name, security number, and/or IP address.

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(Paragraph 0067.) But information is not equivalent to computer program code; information is not executed. Specifically, Wu's information is not embedded program code that, when executed at a recipient node, establishes a voice communications link between an instant message sender and a recipient at the recipient node, as recited in each of the amended independent claims.

Wu's "talk request" also can include information. The information – message type, screen name, security number, and/or IP address – however, again, is not equivalent to computer program code for establishing a voice communications link. Moreover, Wu does not establish a voice-based link based on computer program code conveyed by an instant message. Firstly, Wu at least suggests if not describes the situation whereby each party – the recipient as well as sender – already has the necessary "software" and audio hardware. (Paragraph 0068.) Regardless, however, there is not even the suggestion that the necessary software, or program code, is conveyed to the recipient. Certainly, Wu does not teach, expressly or inherently, that the program code for establishing the voice communications link is embedded in an instant message conveyed to a recipient.

Were Wu to be read otherwise, there would be no need for the host's determining the capability of the recipient. (See paragraph 0068.) If the program code lending the recipient a capability for establishing a voice communications link were embedded in an

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instant message, there would be no reason to check whether the recipient already had such a capability or not since the capability.

More importantly, read in its overall context, Wu's description of a sender and recipient that are talk enabled implies that it is a feature that a subscriber – the sender or recipient – already possesses but that at any moment may or may not be enabled. The reason for Wu's text messaging, accordingly, is to alert a recipient to enable the capability in order to engage in voice communication with the sender of the message. In any event, Wu provides no explicit or inherent teaching about embedding computer program code in an instant message so that a voice communications link can be established by executing the embedded program code, as recited in each of the amended independent claims.

Applicants respectfully maintain, therefore, that Wu fails to expressly or inherently teach every feature recited in amended independent Claims 1, 9, 18, 20, and 28, and that the claims thus define over the prior art. Applicants respectfully maintain further that, whereas each of the remaining claims depend from one of the amended independent claims while reciting additional features, dependent Claims 2-7, 10, 11-17, 21-25, and 29-37 likewise define over the prior art.

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CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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